

Remarks

Applicant thanks the Examiner for kindly indicating that claims 40-42 are allowable.

Claim 1 has been amended. Claims 2-6 have been cancelled without prejudice. Claim 1 has been amended to incorporate the language of claims 2-4. The amendment to claim 1 has been made to speed prosecution and not for reasons related to patentability. Applicants reserve the right to prosecute claims 1-6 in their original form in a continuing application.

Applicant submits that the amendment to claim 1 renders moot the rejection of claims 1, 5, 10, 11, 16 and 17 under 35 U.S.C. § 102(b) over Rabuse et al. (U.S. Patent No. 4,437,362) and requests that it be withdrawn.

Claim 1, previously pending claims 2-4, stands rejected under 35 U.S.C. § 103 over Rabuse et al. in view of Swanson et al. (WO/007882).

Rabuse et al. disclose a roll of adhesive tape that includes an antistatic coating on the edge of the roll. The antistatic coating consists of a soft plastic or a waxy organic composition including an ionic compound that is capable of providing adequate ionic antistatic conductivity.

Swanson et al. is directed to nonwoven sheet materials.

Claim 1, which now incorporates the language of previously pending claims 2-4, is directed to a method of detackifying an edge face of a roll of pressure sensitive adhesive tape. The method includes contacting an edge face of the roll of tape with a non-free radically curable composition that includes water and a film-forming agent, and drying the composition. The film-forming agent includes a polymer selected from the group consisting of ethylene vinyl acetate, polyvinyl acetate, polyvinyl chloride, cellulose, polyurethane, acrylic resin, and combinations thereof. It is undisputed that Rabuse et al. fail to teach the film-formers now recited in claim 1. Rabuse et al. also do not expressly teach a method of detackifying the edge face of a roll of pressure sensitive adhesive tape.

Swanson et al. do not cure the deficiencies of Rabuse et al. To establish a *prima facie* case of obviousness based upon a proposed combination of references there must be a teaching, suggestion or motivation in the prior art for making the proposed

combination. See M.P.E.P. 2142; Fromson v. Anitec Printing Plates, Inc., 132 F.3d 1437 (Fed. Cir. 1997); C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, (Fed. Cir. 1998). Here there is no such teaching, suggestion or motivation. For a rejection on obviousness grounds to be proper, the rejection must contain some articulated reasoning having some rational underpinning to support the legal conclusion of obviousness. In particular, the rejection must set forth some explanation of the reasons why one of ordinary skill in the art would have been motivated to select the references and combine them in such a manner so as to render the claimed invention obvious. *In re Rouff  t*, 149 F.3d at 13567-1359; *see also In re Kahn* 441 F.3d at 988 citing *Cross Med. Prods. Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1321-24 (Fed. Cir. 2005). The February 22, 2006 Office action, by reference to the January 10, 2005 Office action, notes that Swanson et al. list various polymers at page 18, lines 18-25 thereof and takes the position that

[I]t would have been obvious to one of ordinary skill in the art . . . to modify the method of Rabuse et al. by incorporating the polymer components of Swanson et al. in the coating composition to provide coating materials [that] . . . bind to fibrous sheet tape materials.”

See January 10th Office action, page 3. As a preliminary matter, Applicant notes that the exact manner in which the Rabuse et al. and Swanson et al. references are being combined is not fully understood. In the event the rejection is maintained, Applicant respectfully requests clarification.

Rabuse et al. do not teach or suggest “fibrous sheet tape materials.” Rabuse et al. also do not teach or suggest a need for providing a coating material for binding “fibrous sheet tape materials.” Instead Rabuse et al. disclose an antistatic coating for use on the edge of a tape, the backing of which is a film. The backings disclosed by Rabuse et al. include cellulose acetate film and polyvinyl chloride film (see Rabuse et al., col. 4, lines 48-50). Rabuse et al. do not teach or suggest backings that are “fibrous sheet tape materials.” Therefore, the motivation alleged in the February 22nd Office action for combining Rabuse et al. and Swanson et al. has no basis of support in Rabuse et al.

The proposed combination of Rabuse et al. and Swanson et al. is further deficient for at least the following additional reasons. The cited passage from Swanson et al. refers to binders for use on fibrous webs. In particular, Swanson et al. disclose,

“Whatever chemical binder is employed, it should have an affinity for, and readily bind with, the tensilized nonfacturable staple fibers and/or binder fibers comprising the fibrous web.” Swanson et al., page 18, lines 15-17. Swanson et al. disclose saturating the fibrous webs with the binder (see *Id.* at page 19, lines 10-11). Swanson et al. further disclose that the binder is applied to the fibrous web to achieve properties such as tensile strength, tear and hand (see *id.* at page 19, lines 3-9). Swanson et al. do not teach or suggest anything about antistatic compositions, using the binders disclosed therein in an antistatic composition such as the antistatic composition of Rabuse et al., or using the binders disclosed therein on the edge face of a roll of tape. Therefore the skilled artisan familiar with Rabuse et al. would have no reason to look to Swanson et al. and further would find Swanson et al. to have no bearing on the antistatic composition of Rabuse et al.

Rabuse et al. disclose, “A suitable coating composition can be a blend of a water-soluble organic polymer such as polyvinyl alcohol.” Rabuse et al., col. 2, lines 58-60. (Emphasis added.) Vinyl acetate, polyvinyl acetate, polyvinyl chloride, polyurethane and acrylic resin are not water soluble. Thus the skilled artisan would have no reason to select vinyl acetate, polyvinyl acetate, polyvinyl chloride, polyurethane or acrylic resin from Swanson et al. and further would refrain from doing so in light of Rabuse et al.’s requirement for water solubility. For at least these additional reasons Applicant submits that the rejection of claim 1 (i.e., previously pending claims 2-4) under 35 U.S.C. § 103 over Rabuse et al. in view of Swanson et al. has been overcome and requests that it be withdrawn.

Claims 10, 11, 16 and 17 depend from claim 1 and are distinguishable under 35 U.S.C. § 102(b) over Rabuse et al. in view of Swanson et al. for at least the same reasons set forth above in distinguishing claim 1.


Applicant submits that the amendment to claim 1 renders moot the rejection of claim 6 under 35 U.S.C. § 103 over Rabuse et al., claims 7 and 8 under 35 U.S.C. § 103 over Rabuse et al. in view of Hawley’s, claim 9 under 35 U.S.C. § 103 over Rabuse et al. in view of Kosher et al. claim 12 under 35 U.S.C. § 103 over Rabuse et al. in view of Larimore et al. (U.S. 4,751,108), and claims 14-15 under 35 U.S.C. § 103 over Rabuse et al. in view of Kantner et al. (U.S. 5,536,768), and requests that they be withdrawn.

There being no further rejections of record, Applicant submits that the application is in condition for allowance and respectfully requests action in accordance therewith. Applicant invites the Examiner to telephone the undersigned at the number set forth below should a teleconference interview facilitate prosecution of the application.

The Commissioner is hereby authorized to charge any additional fees that may be required and to credit any overpayment to Deposit Account No. 501,171.

Respectfully submitted,

Date: April 21, 2006


Allison Johnson
Reg. No. 36,173

Allison Johnson, P.A.
Lake Calhoun Executive Center
3033 Excelsior Blvd., Suite 467
Minneapolis, MN 55416
Telephone (612) 929-0700
Facsimile (612) 929-0706